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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: B. Herman Attorney Docket No.: WEYE121980/24877
Application No.: 10/727,442 Group Art Unit: 3643
Filed: December 3, 2003 Examiner: J.L. Gellner
Title: USE OF CYTOKININ TO PROMOTE
GROWTH OF SHOOTS FROM A LOG

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Seattle, Washington 98101

August 10, 2005

TO THE COMMISSIONER FOR PATENTS:

Applicant requests review of the final Rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

ARGUMENTS

Rejection of Claims 1-14 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Cuenca et al. (Plant Cell, Tissue and Organ Culture 60:213-220, 2000) at Least in View of Saul et al. (Forest Research Note No. 33, Ministry of Natural Resources, Ontario, Canada, 1982)

Applicant respectfully submits that the Examiner has omitted an essential element needed for a *prima facie* case of obviousness. In particular, applicant respectfully submits that the Examiner has failed to show proper motivation for modifying the teachings of the Cuenca et al. reference.

Consistent with the requirement for brevity, the members of the reviewing panel are referred to the Response to Office Action, filed on February 15, 2005, for a fuller discussion of applicant's response to the rejection of Claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over Cuenca et al. at least in view of Saul et al. In brief, for the following reasons,

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applicant respectfully submits that the Examiner has failed to show proper motivation for modifying the teachings of the Cuenca et al. reference in view of Saul et al.:

1. Applicant submits that modifying the Cuenca et al. method in the manner suggested by the Examiner would render the Cuenca et al. method unsatisfactory for its intended purpose. Cuenca et al. disclose an *in vitro* method of regenerating adventitious buds from 2-3 mm-long internode segments of Beech shoots (see, Cuenca et al., page 214, paragraph entitled "Adventitious bud induction"). In contrast, Saul et al. disclose the vegetative propagation of Alder by use of rooted cuttings (see, e.g., Saul et al., pages 1-2, section entitled "Materials and Methods"). Saul et al. used 10-16 cm long cuttings (referred to as "logs" by the Examiner) collected from 20-25 year old Alder trees. The Examiner argues that it would have been obvious to modify the method of Cuenca et al. by using a log as disclosed by Saul et al. so as to have a practical way of propagating cuttings of alder with both shoots and roots so as to increase the developmental speed of improved genotypes. Applicant submits that it would be impractical to culture 10-16 cm long cuttings on medium *in vitro*. For example, a large and cumbersome container would be required to culture the 10-16 cm long cuttings. Thus, applicant submits that modifying the Cuenca et al. method in the manner suggested by the Examiner would render the Cuenca et al. method unsatisfactory for its intended purpose.

2. Applicant submits that there is no reasonable expectation of success to modify the method of Cuenca et al. by using cuttings as disclosed by Saul et al. Applicant submits that cuttings from 20-25 year old trees (as used by Saul et al.) are physiologically different from internodal segments of shoots that have been continuously cultured on growth medium *in vitro* (as used by Cuenca et al.). Consequently, applicant submits that it cannot be inferred that the method of Cuenca et al. would produce adventitious buds, then shoots, from the cuttings used by Saul et al. In this regard, Cuenca et al. teach that the ability of different parts of a Beech plant

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(e.g., stem internode sections versus leaves) are not equally amenable to the production of adventitious buds (see, Cuenca et al., page 220, second paragraph of first column).

3. At page 6 of the Office Action dated May 17, 2005, in response to applicant's arguments, the Examiner states that to incorporate the use of a log would not render the Cuenca method unsatisfactory, or impractical, for its intended purpose "because the last paragraph of the "Introduction" section (on page 214, Col. 1) Cuenca et al. states that "shoot cultures of juvenile origin were used as an intermediary step on obtaining bud regeneration from adult material in the field." Hence, according to the Examiner, "Cuenca et al. has a goal of using a log, adult material, which, in fact, Saul et al. discloses." Applicant notes that Cuenca et al. merely state a desired goal of obtaining bud regeneration from adult material in the field. Applicant submits that Cuenca et al. provide no guidance with respect to the use of adult material, and, indeed, teach that different types of beech material (e.g., stem internode sections versus leaves) respond differently to tissue culture (see, Cuenca et al., page 220, second paragraph of first column).

Similarly, at page 6 of the Office Action dated May 17, 2005, the Examiner states that "the cutting from older planter material may be physiologically different from internodal segments of shoots that have been continuously cultured on a growth medium in vitro but, since the goal of Cuenca et al. is to use adult material, one of ordinary skill in the art would have found it obvious to alter the method of Cuenca et al. to use logs." Again, applicant submits that the Examiner is merely stating, in a conclusory manner, that it is obvious to alter the method of Cuenca et al. to use logs. Neither the Examiner nor Cuenca et al. provide guidance as to how one of ordinary skill in the art would alter the method of Cuenca et al. to use logs.

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CONCLUSION

For the foregoing reasons, and as discussed more fully in the Response to Office Action, filed on February 15, 2005, applicant respectfully submits that the Examiner has failed to show proper motivation for modifying the teachings of the Cuenca et al. reference. Accordingly, applicant requests that the rejection of Claims 1-14 under 35 U.S.C. § 103(a) be withdrawn.

Respectfully submitted,

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